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EXAMINER

WALSH, JOHN B

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2451

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/919,153	Applicant(s) SCHRECKENGAST ET AL.	
	Examiner John B. Walsh	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: a physical storage device.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitation of "a physical storage device". The original disclosure does not provide support for a physical storage device nor has any indication been given where such support for the newly amended limitation can be found.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 19-27 as best understood are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 19-27 recite the term "method". The claim does not recite patent eligible subject matter since it does not fall within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. It appears the applicant intends to claim a process. For purposes of 35 USC 101, a process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Neither of these requirements are met by the claim, thus it is non-statutory.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-27 as best understood are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,082,407 to Bezos et al.

As concerns claim 1, a proprietary information utility comprising: an interface (figure 5-website system) that provides outside entities connection to the proprietary information utility; a repository (figure 5; databases/storage medium storing the webpages and data) that contains proprietary information, wherein the repository is compartmentalized by user identity and entitlement (column 4, lines 61-67-categories drawn to customer/user are stored in the repository thus the repository is compartmentalized; col. 7, lines 56-57 - entitlement to particular

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communities), so that a first category of proprietary information is within private domains (private data; col. 2, line 25) available to only a single user (users profile-user would log in to account to change their profile; col. 13, lines 64-65) and a second category of proprietary information is within domains to which multiple users (public data) may be granted use in response to paying a subscription fee (col. 4, line 55) to use particular proprietary information within the second category of proprietary information; application services (searching the webpages); a security system (secure webpages and data), that limits access of each user connecting to the proprietary information utility to proprietary information to which each user is entitled, the proprietary information to which each user is entitled being accessed through use of the application services; and, a billing system (billing system for purchasing products/services from website; figure 3-shopping cart) for tracking usage by users of the proprietary information utility for billing purposes; wherein the first category of proprietary information comprises works of authorship in which the single user has proprietary rights (user purchases an item from the repository and thus has ownership rights; furthermore a user can be an author purchasing their own works).

As concerns claim 2, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes decision support software (figure 5; website runs off software).

As concerns claim 3, a proprietary information utility as in claim 1 wherein the application services include services to perform at least one of the following activities related to patents: help identify patentable ideas; create patent disclosures; manage pending patents;

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manage research logs; and, research existing patents (col. 4, lines 57-60; search for books on patents).

As concerns claim 4, a proprietary information utility as in claim 1 wherein the application services include at least one of the services listed below: decision support software; software for troubleshooting products; system configuration services; diagnostic services; planning services; selection services; authoring tools that help authors generate appropriate software models; learning services for data-mining and the ongoing evolution of models; business intelligence services; version management services; presentation services; brokering services; stock selection services; investment portfolio troubleshooting services; investment portfolio selection services; services to troubleshoot devices; medical diagnosis services; services that predict failure and behavior; purchasing decision services; consulting services; skills gap analysis services; translation services for translating decision support models from one underlying technology to another; enterprise resource planning services; and, customer relationship management services (search for books on investment portfolio).

As concerns claim 5, a proprietary information utility as in claim 1 wherein the first category of proprietary information contains health records and the application services include services to provide services for supporting healthcare and patients, without revealing private information (books on health in a users cart).

As concerns claim 6, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes proprietary information within at least one of the areas listed below: decision support models; and, models associated with troubleshooting products (books on decision support models).

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As concerns claim 7, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes decision support models that are based on at least one of the technologies listed below: Bayesian networks; neural networks; case-based systems; model-based systems; rule-based systems; fuzzy systems; decision trees; genetic algorithms; Monte Carlo Markov chains; clustering algorithms; Monte Carlo optimization; simulated annealing; pattern matching; influence diagrams; online analytical processing; collaborative filtering; linear programming; machine learning; and, time series (books on Bayesian networks).

As concerns claim 8, a proprietary information utility as in claim 1 wherein the interfaces allows users to connect to the proprietary information utility using at least one of the following deployment channels: wireless network; cellular phones; internet sites; applications embedded in appliances; applications embedded in devices; applications embedded in vehicle communication and information systems; applications embedded in intelligent agents; and, applications embedded in memory modules (figure 5; internet sites).

As concerns claim 9, a proprietary information utility as in claim 1 wherein the application services include services to support the creation, maintenance, and deployment of decision support models, in at least one of the following areas: data-mining; usage reports; business intelligence reports; adaptive learning and refining of models; authoring wizards particular to specific horizontal and vertical industries; and, quality benchmarks of models (books on data-mining).

As concerns claim 10, a proprietary information utility as in claim 1 additionally comprising: an application service registry that manages dynamic registration, access, use, and disposal of the application services (figure 5; col. 13, lines 64-65-login/access).

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As concerns claim 11, a proprietary information utility as in claim 1 additionally comprising: a proprietary information broker that maps semi-structured proprietary information requests to a most appropriate proprietary information model and application services that will operate on the most appropriate proprietary information model (website lists related products to desired products).

As concerns claim 12, a proprietary information utility as in claim 1 wherein the security system provides non-repudiation services in support of billing and reporting (billing information entered on a secure site).

As concerns claim 13, a proprietary information utility as in claim 1 wherein the security system provides privacy for all information transmitted outside of the proprietary information utility, allowing proprietary services to make use of proprietary information utility without revealing anything about users of the proprietary services and without revealing contents of data moving between services (private data is secure not un-secure public data).

As concerns claim 14, a proprietary information utility as in claim 1 wherein the billing system provides revenue to be generated using at least one of the following pricing schemes: pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows; subscription-based pricing; and, price bundling (col. 4, line 55).

As concerns claim 15, a proprietary information utility as in claim 1 additionally comprising: a scaleable computing engine that runs services across many pieces of information (search engine for website).

As concerns claim 16, a proprietary information utility as in claim 1 additionally comprising: a computing engine, the computing engine being used to translate information from

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an author into a utility-native proprietary information format that can be used by a least a subset of application services within the proprietary information utility (search terms entered into search engine on website).

As concerns claim 17, a proprietary information utility as in claim 1 wherein the billing system calculates royalty payments due to authors when proprietary information of the authors is used by the application services within the proprietary information utility (authors receive royalty payments based on books sold).

As concerns claim 18, a proprietary information utility as in claim 1 additionally comprising an application service registry that manages dynamic registration, access, use, and disposal of the application services, the application service registry providing a service catalog, a discovery mechanism, and a brokering interface that links with the proprietary information broker and the security system to provide a custom view of available application services; based on entitlement and visibility (wish list or items in cart or items resulting from a search).

As concerns claim 19, a method comprising the following steps: (a) providing outside entities connection to a proprietary information utility (figure 5-website system); (b) storing proprietary information within a repository, wherein the repository is compartmentalized by user identity and entitlement (figure 5-databases/memory storing data relating to users; wish list; items ordered) so that a first category of proprietary information is within private domains (private data; col. 2, line 25) available to only a single user and a second category of proprietary information is within domains to which multiple users (public data-information for electronic download-col. 4, line 50) may be granted use in response to paying a subscription fee (col. 4,

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lines 52-55) to use particular proprietary information within the second category of proprietary information; wherein the first category of proprietary information comprises works of authorship in which the single user has proprietary rights (user purchases an item from the repository and thus has ownership rights; furthermore a user can be an author purchasing their own works); (c) limiting access of each user connecting to the proprietary information utility to proprietary information to which each user is entitled, the proprietary information to which each user is entitled being accessed through use of application services operating within the proprietary information utility (private data; col. 7, line 25; users account; col. 13, lines 64-65), wherein multiple users can be granted access to the same proprietary information (public users may access books and items sold on website; wherein a private user may buy the same products); and, (d) tracking usage of users of the proprietary information utility and billing (fig. 3; users cart on website).

As concerns claim 20, a method as in claim 19 additionally comprising the following step: (e) managing dynamic registration, access, use, and disposal of the application services (user sets up an account; col. 13, lines 64-65).

As concerns claim 21, a method as in claim 19 additionally comprising the following step: (e) mapping semi-structured proprietary information requests to a most appropriate proprietary information model and application services that will operate on the most appropriate proprietary information model (website lists related products to desired products).

As concerns claim 22, a method as in claim 19 wherein step (c) includes providing non-repudiation services in support of billing and reporting (user enters payment info).

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As concerns claim 23, a method as in claim 19 wherein step (c) includes providing privacy for all information transmitted outside of the proprietary information utility, allowing proprietary services to make use of proprietary information utility without revealing anything about users of the proprietary services and without revealing contents of data moving between services (private data transmitted securely; entered on a secure webpage).

As concerns claim 24, a method as in claim 19 wherein step (d) includes providing revenue to be generated using at least one of the following pricing schemes: pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows; subscription-based pricing; and, price bundling (col. 4, line 55).

As concerns claim 25, a method as in claim 19 additionally comprising the following step: (e) translating information from an author into a utility-native proprietary information format that can be used by a least a subset of application services within the proprietary information utility (webpage presents text from books in another format for viewing on the webpage).

As concerns claim 26, a method as in claim 26 wherein step (d) includes calculating royalty payments due to authors when proprietary information of the authors is used by the application services within the proprietary information utility (author receives royalty payments based on number of books sold).

As concerns claim 27, a method as in claim 19 additionally comprising the following step: (e) providing a service catalog, a discovery mechanism to provide a custom view of available application services, based on entitlement and visibility (user can search by topic).

Response to Arguments

8. Applicant's arguments filed August 8, 2008 have been fully considered but they are not persuasive.

The applicant argues Bezos does not disclose “a repository compartmentalized by user entitlement.” The claims have been given the broadest reasonable interpretation and the data being stored in the repository is categorized to various customer/user data thus the repository is organized such that this data can be retrieved for later use and is thus compartmentalized by user identity. Bezos also discloses storing in the repository the user's association or membership to a particular communities and thus decides which communities a user is entitled to. Furthermore, the user is entitled certain access based on logging in with their username and password.

The applicant argues Bezos does not disclose “private domains available only to a single user.” The claims have been given the broadest reasonable interpretation and Bezos discloses the user/customer has various personal/customer data stored in the repository (see col. 4, lines 61-65) that is available only to that user via a login or authentication procedure (see col. 13, lines 64-65) and thus anticipates the claim limitations.

The applicant argues Bezos does not disclose works of authorship in which the single user has proprietary rights. The claims have been given the broadest reasonable interpretation and this new limitation has been addressed in the rejection above.

The applicant argues Bezos does not disclose a second category of information compartmentalized by user identity and entitlement. The claims have been given the broadest reasonable interpretation and the repository of Bezos can store various data including data available to multiple users, public, that when purchased via a subscription (see col. 4, lines 52-

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55) the user is granted access to this information stored on the repository. Furthermore such information is compartmentalized based on its content, such as being downloaded only after a subscription is authorized, entitling the user to access. Such information is compartmentalized so that it can correctly identify for delivery to the user.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/
Primary Examiner, Art Unit 2451